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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITSUO YAMADA, HIROSHI KUMAGAI, KATSUMI
MOROHOSHI, and YUICHI FUJINUMA

Appeal 2009-013419
Application 10/617,731
Technology Center 1700

Decided: March 22, 2010

Before JEFFREY T. SMITH, LINDA M. GAUDETTE, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-4 and 7-19. (Office Action, mailed November 5, 2007). We have jurisdiction under 35 U.S.C. § 6(b).¹

We AFFIRM.

STATEMENT OF THE CASE

Claim 1 is illustrative of the subject matter on appeal, and is reproduced from the Claims Appendix to the Appeal Brief ("App. Br."):

1. A resinous tube comprising:

at least one first cylindrical resin layer (A) comprising at least one resin selected from the group consisting of polybutylene terephthalate (PBT), polybutylene naphthalate (PBN), polyethylene terephthalate (PET) and polyethylene naphthalate (PEN); and

at least one second cylindrical resin layer (B) formed generally coaxially with the at least one first cylindrical layer and comprising at least one copolymer which comprises polybutylene terephthalate (PBT) copolymer or polybutylene naphthalate (PBN),

wherein the at least one second cylindrical resin layer (B) is in direct contact with and serves as a supporting layer for the least one first cylindrical resin layer (A),

wherein the at least one second cylindrical resin layer (B) comprises a block copolymer which comprises at least one segment selected from the group consisting of polybutylene terephthalate (PBT) and polybutylene naphthalate (PBN) as a hard segment, and

at least one segment selected from the group consisting of polytetramethylene glycol and polycaprolactone as a soft segment,

¹ In rendering this decision we have considered Appellants' Brief dated March 20, 2009. An oral hearing was held for this appeal on March 10, 2010.

wherein a cylindrical resin layer forming an innermost layer of the resinous tube is electrically conductive.

THE REJECTIONS

Appellants request review of the following grounds of rejection:

I. Claims 1-4, and 12-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Smith, U.S. Patent 6,591,871 B2, issued July 15, 2003 and Ito '312, U.S. Patent 6,576,312 B1, issued June 10, 2003.

II. Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Smith, Ito '312, and Ito '330, U.S. Patent 6,619,330 B2, issued September 16, 2003.

III. Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Smith, Ito '312, and Ozawa, U.S. Patent 6,589,647 B1, issued July 8, 2003.

PRINCIPLES OF LAW

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

ISSUE

Did the Examiner err in determining that the combination of Smith and Ito '312 would have rendered obvious to a person of ordinary skill in the art a resinous tube comprising a cylindrical resin layer (B) is in direct contact with and serves as a supporting layer for the least one cylindrical resin layer (A) as required by the independent claim 1?² We answer this question in the negative. Therefore, we AFFIRM.

ANALYSIS

Appellants have not presented arguments for all the claims subject to the obviousness rejections. Appellants' arguments presented for the claims identified under separate headings are the same as those presented in rebuttal to the Examiner's rejection of independent claim 1. Any claim not separately argued will stand or fall with independent claim 1. We will address all of the separately argued claims. We begin our discussion with claim 1.

The Examiner found that Smith discloses a resinous fuel transport tube comprising a first cylindrical resin layer selected from the group consisting of PBT, PBN, PET and PEN and in adjacent/direct contact with a second cylindrical resin layer selected from the group consisting of PBT or PBN and further comprising an innermost cylindrical layer which is electrically conductive comprising PBT or PBN. (Ans. 3-4). The Examiner found that Smith differed from the claimed invention in that the second layer

² The issue presented for review of all rejections is the same. Appellants did not dispute the Examiner's reason for citing the Ito '330, and Ozawa references. Specifically, Appellants state that Ito '330, and Ozawa fail to resolve the fundamental deficiencies in Smith. (App. Br. 12, 15). Thus we will address the rejections together.

is not described as comprising a blocked copolymer which comprises at least one segment selected from the group consisting of a blocked copolymer which comprises at least one segment selected from the group consisting of PBT and PBN as a hard segment, and at least one segment selected from the group consisting of polytetramethylene glycol and polycaprolactone as a soft segment. (Ans. 4). The Examiner found that Ito '312 described a resinous layer comprising the components of the second layer of the presently claimed invention. The Examiner found that the resinous layer of Ito '312 provides excellent resistance to permeation of gasoline, detergent resistance and hydrolysis resistance. (Ans. 5; Ito '312, col. 2, ll. 61-67). The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to utilize the resinous layer of Ito '312 in the tube of Smith to obtain the advantages disclosed above. (Ans. 5-6).

Appellants argue that Smith fails to disclose the claimed invention because there is no disclosure of a first cylindrical resin layer (A) in direct contact with the second cylindrical resin layer (B) as required by independent claim 1. Appellants argue that Smith discloses the cover layer is adjacent to the outside surface of the outside wall of the hose and that it may be desirable to incorporate a "tied layer" between the hose and a cover. (App. Br. 7). Appellants' argument is not persuasive. Smith's disclosure that the resinous layers are adjacent to one another would have suggested to a person of ordinary skill in the art that these layers could have been in direct contact with one another. This is further supported by Smith's disclosure that the "tied layer" may be incorporated between the layers. A person of ordinary skill in the art would have reasonably expected from the teachings of Smith that the "tied layer" is optional and can be excluded in between the

layers thus providing the layers in direct contact with one another. “For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988).

Appellants’ arguments regarding Smith’s failure to disclose the same second cylindrical resin layer as the claimed invention is not persuasive. The Examiner relies upon Ito ‘312 for describing the composition of this layer. Appellants have not asserted that it would not have been obvious to a person of ordinary skill in the art to incorporate this layer into the tube of Smith as suggested by the Examiner.

Appellants have failed to explain the significance of the comparative data in the Specification. (App. Br. 8). It is well settled that the burden of establishing the practical significance of data in the record with respect to unexpected results rests with Appellants, which burden is not carried by mere arguments of counsel. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Under these circumstances, we cannot conclude that the Examiner erred in the determination that the appealed subject matter would have been obvious under 35 U.S.C. § 103. Therefore, the rejections of claims 1-4 and 7-19 under § 103 are affirmed.

CONCLUSION

The decision of the Examiner rejecting claims 1-4 and 7-19 is affirmed.

Appeal 2009-013419
Application 10/617,731

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

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